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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,058	12/11/2003	Hikaru Kobayashi	075834.00460	7840
33448	7590	02/26/2010		
ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			EXAMINER MARINI, MATTHEW G	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 02/26/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,058

Applicant(s)

KOBAYASHI ET AL.

Examiner

MATTHEW G. MARINI

Art Unit

2854

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayama (JP 11-157137). Note: The examiner has relied upon U.S. Patent # 6,532,078 as an English translation of Hayama (JP 11-157137).

As to claims 7 and 10, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, for use in a roll printer, comprising; a printing surface, the top surface of T1, on which one or more images are capable of being printed; a printing layer that is releasably adhered to a release layer, Col. 14 lines 5-13, the release layer for holding said printing layer, top surface of T1, wherein the releasably adhered printing layer, top surface of T1, and the release layer are rolled together in a spiral shape for form a roll-shaped printing medium, as seen in Fig. 2.

The examiner would like to point out that claim is directed towards a roll-shaped printing medium, where the preamble defines an intended use for that roll-shaped printing medium, i.e. to be used in a roll-printer. (Note that the printer is not part of the claimed combination, but rather a mere intended use.) Therefore, the language directed towards how the roll-shaped printing medium is to be used in the roll-printer reads as intended use, i.e. how the roll-shaped printing medium is to be cut and printed in the roll-printer. The structure of the prior art described above is capable of performing the intended use of the roll-shaped printing medium being used in a

printer. Said differently, the roll-shaped printing medium of Hayama, if placed in the intended use printer, will be capable of being cut and printed according to claim 7 and 10.

As to claim 8, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, being used in a roll printer wherein said image forming portion, top surface of T1, extends substantially the entire longitudinal length of said print medium, T1, as seen in Figs. 16A-C.

Response to Arguments

Applicant's arguments filed 11/12/09 have been fully considered but they are not persuasive.

As described above in the rejection of claim 7 and 10, the language directed towards how the roll-shaped printing medium is cut in the "for use" recitation of a printer, reads as an intended use limitation. Insofar as what is structurally recited defining the roll-shaped medium, the prior art of Hayama is capable of performing the recited intended use of the roll shaped printing medium being used in a printer (which is not part of the claimed combination) and how that medium can be cut.

Note, applicant argues that "these lateral cuts are not pre-formed but are made only after image has been applied to the printing material" by the roll printer. Because the roll shaped medium is directly claimed, where the printer is an intended use limitation, how the roll-shaped medium is used within the printer is treated as functional language. The claimed structure defining the roll-shaped medium is capable of being laterally cut because the roll-shaped medium is capable of being used in such a printer, where the is not part of the claimed combination and merely an intended use limitation of how the roll shaped medium is used.

Therefore, Hayama is being relied upon for teachings of a roll-shaped medium “for use in a printer”, and not the printer being disclosed within the reference. The taught roll-shaped medium is capable of being laterally cut by a printer according to what will be printed and what is printed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW G. MARINI whose telephone number is (571)272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Judy Nguyen can be reached on (571)-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Marini
February 26, 2010

/Daniel J. Colilla/
Primary Examiner
Art Unit 2854